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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,668	09/07/1999	SHIMON SHNITZER	U-012394-7	1592

140 7590 12/04/2002

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EXAMINER

EMDADI, KAMRAN

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/392,668

Applicant(s)

SHNITZER ET AL.

Examiner

Kamran Emdadi

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 41.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the phrase "local level" as referred to in the claim has no description as to what it describes or encompasses, and is thus rendered indefinite.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
5. Claims 1-13, 15, 16, 18-21, 26, 27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson (US Patent No. 6169734).

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- Regarding claims 1, 7, 13, ~~26~~ and ~~29~~, Wilson teaches: a telephone set 50 with a connection 88 to a computer 90 (Figure 2) where the device can process analog/digital signals for transmissions on a network, (Col 3, lines 60-63).
- Regarding claims 2, 3, 8, 9 Wilson teaches: output ports to a telephone socket 80, 82 and 84 (Figure 2), where 84 is the connection to the PSTN.
- Regarding claims 4, 5, 10, 12 Wilson teaches: a process of adding parameters including: IP address, domain name server address and a phone number to be stored in a readily accessible data storage device, where the data is entered by the keypad (Col 6, lines 6-12).
- Regarding claims 6 and 11, Wilson teaches: the computer can interact with Internet (Col 4, lines 50-55).
- Regarding claim 15, Wilson teaches: voice as a type of communication to be conducted (Abstract).
- Regarding claim 16, Wilson teaches: all of the above embodiments and a computer 15 having control software for controlling a phone system attached (Col 3, lines).
- Regarding claim 18, Wilson teaches: a program used to exchange data for a call (Col 3, lines 27-35).
- Regarding claim 19<sup>26, 29</sup>, Wilson teaches: all of the above embodiment and a connection to the PSTN 84 and a computer 90 where the telephone has an internal digital switch type control mechanism coupled to the phone instrument and where voice is transferred to the PSTN and to its internal digital switch processing unit

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and signaling information to the computer through the wired connection 88 (Figure 2).

- Regarding claim 20, Wilson teaches: a ringer circuit 165 where the ringer is attached to voltage dependent components of an electronic circuit (Figure 3), where the components of figure 3 represent the internal structure of a phone 50 of figure 2 and that phone having a connection the a PSTN (Figure 2).
- Regarding claim 21, Wilson teaches: all of the above embodiments and it is an inherent feature of the PSTN to generate a voltage signal when attempting to ring a phone within its switching capacity.
- Regarding claim 27, Wilson teaches: all of the above embodiments and least cost routing as a related article to the invention herein "Schreyer et al., Least Cost Call Routing, Apr. 1996."

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent No. 6169734) in view of Turock (US Patent No. 6243373).

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- Wilson teaches a telephone device that attaches to a computer containing all of the above embodiments except the digital conversion of an analog voice signal to be sent to the attached computer and the use of encryption within the software processing. Turock teaches the use of an analog to digital conversion process for a transmitting computer to send a voice signal digitized to a receiving computer which does analog to digital voice conversion (Col 4, lines 5-13) and a module used to encrypt a voice message from being tampered with over the Internet (Col 10, lines 42-44). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an analog to digital converter and a digital to analog converter in a single phone unit to send and receive calls that are originally analog over a digital signaling medium to simulate a typical phone conversation consisting of both parties talking and listening while being protected from potential eavesdropping.

8. Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent No. 6169734) in view of Ng et al. (US Patent No. 6373835).

- Regarding claims 22-25, Wilson teaches: a telephone device interfaced to a computer and all of the above embodiments except a method to include conference calls of more than two individual callers communicating in the same call. Ng teaches: a tele-conferencing call taking place between more than two callers over the Internet while interfacing with the PSTN. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of a conferencing mechanism to include more uses

associated with voice calls for added functionality and desirability to a phone type device.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent No. 6169734) in view of Foster et al. (US Patent No. 6466550).

- Regarding claim 28, Wilson teaches: a telephone device interfaced to a computer and all of the above embodiments except a method of mixing voice information. Foster et al. teaches: voice and over the Internet with mixing of voice data (Col 5, lines 45-64). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of a mixer mechanism for a method of data processing that provides an arbitration process for effective data screening.

10. Claims 30, 32 and 33, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent No. 6169734) in view of Ford (US Patent No. 6463051).

- Regarding claims 30, 32 and 33, Wilson teaches: a telephone device interfaced to a computer and all of the above embodiments except a card slot. Ford teaches: a card for interfacing 20 and a card for networking 30 for voice to be carried over the Internet (Figure 1). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the use of a card for communicating data to the computer for voice over the Internet data transfer.

*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Szviatovszki et al. (US Patent No. 6470010) speech connection in a network.
- Pinard (US Patent No. 6363140) Screening profile.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamran Emdadi whose telephone number is (703) 305-4899. The examiner can normally be reached between the hours of 8am and 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached at (703) 305-4366. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9314 for regular communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Kamran Emdadi

11/25/2002

KWANG BIN YAL  
PRIMARY EXAMINER  
